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John D. Dreher

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THE ESTEE LAUDER COS, INC
155 PINELAWN ROAD
STE 345 S
MELVILLE, NY 11747

EXAMINER

YU, GINA C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/482,773
Filing Date: January 13, 2000
Appellant(s): DREHER, JOHN D.

CYNTHIA R. MILLER
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on December 9, 2008 and September 17, 2009 appealing from the Office action mailed on May 29, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

- (A). Ex parte JOHN D. DREHER, decision mailed on March 22, 2007.
Appeal No. 2007-0627
Application No. 09/482, 773 (the present application)
- (B) Application No. 11/137,060, appeal brief filed on November 16, 2009.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct. The numbering of claim 35 is corrected in the rejection statements in the present examiner answer.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5690916	KIMURA ET AL.	11-1997
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6207174 B1	HINENO ET AL.	03-2001
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"Wrinkles and Wrinkle Treatments" www.skin-care-reviews.com, printed on February 15, 2007.

Hurst, S, "Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993, Chapman and Hall, (9th ed. by Hilda Butler), pages 116-121.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 7, 9, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kimura (US 5,690,916) as further evidenced by Wrinkles and Wrinkle Treatments (www.skin-care-reviews.com).

Kimura discloses a foundation comprising 9.0 % by weight of blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13; instant claims 1-5, 7, 9, and 11.

The claimed method of covering wrinkles of the skin as recited is inherently practiced by using the prior art composition, since wrinkles and lines are natural event

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and lines and wrinkles may be visible as early as 20-25 years of age. See Wrinkles and wrinkle treatments, p. 4.

In Ex Parte John D. Dreher, the Board stated on p. 6, "application of the makeup composition to the skin of a person 25 to 35 years of age and older is inherent application to skin of a person 25 to 35 years of age and older is inherent application to skin exhibiting lines and wrinkles". See Appeal No. 2007-0627, (March 22, 2007), p. 5, bridging par. – p. 6, last par. Although the new limitation now requires the method step as applying to "the skin exhibiting age-associated lines and wrinkles", the board has clearly indicated that anytime the Kimura invention is applied to the skin of person 25 to 35 years of age and older, it is inherently applied to skin exhibiting age-associated line and wrinkles.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7, 9-11, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hineno (US 6207174 B1) in view of Kimura.

Hineno teaches a composite powder composition comprising interference or reflective pigments, which is effective in covering wrinkle and improving skin color. See Examples 1 and 2; Tables 2 and 3. Example 6 discloses a foundation comprising sericite, iron oxides, and 9.32 % by weight of composite powder. See instant claims 1-7. Although the reference does not explicitly mention that the wrinkle is age-associated wrinkle, it would have been obvious that the prior art composition comprising

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interference pigments and inorganic powder would effectively camouflage the skin defect (i.e. wrinkles) regardless of the cause.

While the exemplified formulations contain 5 % of red interference pigments, blue interference pigments are also taught in the specification, col. 13-14, Production Example (4), and in col. 5, Table 1. See instant claim 10.

As discussed above, Kimura teaches a foundation comprising 9 % blue interference pigment and iron oxides, 11.0 % by weight of titanium dioxide, and sericite, other non-interference inorganic pigments. See Example 13.

Given the teaching of Hineno that interference pigments used in cosmetics cover wrinkles on the skin, It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the exemplified cosmetic formulations of Hineno by using blue interference in a foundation as motivated by Kimura because 1) Hineno also generally teaches blue interference pigments useful for the invention; and 2) Kimura illustrates an example of a foundation comprising blue interference pigments. The skilled artisan would have had a reasonable expectation of successfully enhancing wrinkle coverage effect on the skin by applying a cosmetic composition comprising blue interference pigments.

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Hineno and Kimura as applied to claims 1-7, 9-11, and 35 above, and further in view of Hurst ("Face Powders", Poucher's Perfumes, Cosmetics and Soaps, 1993).

Hineno and Kimura, discussed above, fail to teach bismuth oxychloride.

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Hurst teaches that bismuth oxychloride is the first synthetic pearlescent pigment and now developed to provide an improved photosensitivity. See p. 117, 2nd full par. The reference further suggests that it is possible to formulate compositions using pearlescent pigments to provide “translucent luster, or frosted effect, to enhance the wearer’s natural complexion”. See p. 117, 5th full par.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the method of the combined references by adding bismuth oxychloride to the cosmetic composition comprising blue interference pigments, as motivated by Hurst, because of an expectation of successfully producing a composition with luster or frosted effect to enhance the natural look of the user.

(10) Response to Argument

A. REJECTION UNDER 35 U.S.C. § 102 (b)

i) No patentable distinction exists between the user populations of the present invention and of the prior art.

Appellant asserts the cited extrinsic evidence fails to support the present anticipation rejection. Appellant asserts that the Kimura method and the present method are not necessarily directed to the same population of people in need of such treatments on their skin.

In response, examiner respectfully points out that the argument is not commensurate with the scope of the claims because the present claims do not require the user population to be in need of age-associated wrinkle treatment. Also in response to the appellant’s argument, examiner asserts that the present invention cannot be

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positively distinguished from that of the prior art. Even appellant admits in specification, p. 1, second paragraph, that “[t]he inevitable process of aging, whether chronological or UV-induced, strikes everyone. . . even younger women now are more conscious of the early development of lines, which may result from excessive exposure to sun due to an active outdoor lifestyle”. Such statements by appellant suggest that the population undergoing the present cosmetic wrinkle treatment method is indistinguishable from those who use the same cosmetic composition for treating a specific skin condition, such as hyperpigmentation as in Kimura because everyone is affected by skin aging. Furthermore, Wrinkles and Wrinkle Treatment also indicates that the extrinsic factors that cause skin lines and wrinkles occur due to the repeated exposure to sun, UV light, and/or pollution over the course of time, during which a person ages also. The reference thus also negates appellant’s assertion that population having “age-associated lines and wrinkles” can be distinctively identified from those undergoing the hyperpigmentation treatment of the Kimura method.

ii) The user population of the Kimura patent is no exception to normal process of inevitable skin aging.

Appellant states the prior art method has been practiced by the step of applying “a blue interference pigment, to blue discolored skin in the lateral ocular area of an Asian female”. However, appellant’s allegation that the prior art composition was applied to Asian females only is inaccurate and a conjecture at best because the reference in fact does not indicate such limitation on the user population of the patent. In Example 13, Kimura merely indicates that the composition was applied to “a panel

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whose face has a light blue portion"; no particular mention of "Asian female" subject was made in the disclosure. Furthermore, nowhere in Kimura does the reference teach or suggest that the prior art method is intended for a limited race or gender. Also, Kimura is directed to a treatment of various hyperpigmentation disorders including angioma, red face, spots, and freckles, which affect diverse racial groups; appellant fails to show Asian females is the only intended user population of the prior art. Even the fact that the patentee had sought the patent right in the United States implies that the prior art product was intended for diverse population, inclusive of all racial groups.

Appellant also relies on a presupposition that Asian female skin somehow do not undergo the normal progress of skin aging that is described in Wrinkles and Wrinkle Treatment, citing a cultural habit of avoiding sunlight. This argument is hearsay at best. Even if the Kimura invention were intended for Asian females only, which it is not and appellant has failed to prove, appellant's argument here is unfounded. Appellant's statement that the skin of a particular racial/gender group is age-proof lacks sound evidentiary support. Skin aging is a natural, inevitable process for all humans, as supported by the extrinsic evidence of the rejection and admitted by appellant.

iii) A prima facie case of anticipation has been properly made.

As discussed in the rejection, all population is susceptible to skin aging, and age-associated lines and wrinkles are exhibited in all skin types. According to the extrinsic evidence, lines and wrinkles are visible even in a person as young as 20-25 years old, and the user population of the presently claimed method are undistinguishable from those of the prior art method. Examiner asserts that the anticipation rejection has been

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properly made, as the presently claimed cosmetic method is inherently anticipated by the Kimura method of treating patients with a specific skin condition by using the same composition of the present invention.

B. REJECTIONS UNDER U.S.C. § 103 (a)

i) The utility of interference pigments in hiding skin wrinkles has been already known by Hineno ('174), and making cosmetics with different color is well within the skill of cosmetic art.

Examiner reiterates that Hineno ('174) expressly teaches the specific cosmetic utility of using interference pigments in cosmetic compositions, which includes covering wrinkles and lines on the skin as well as improving the skin color, excellent spreading in coating, and dry feeling after coating. See Tables 2 and 3. Hineno further teaches the production of blue interference pigments, and Kimura teaches makeup composition comprising blue interference pigments used to camouflage hyperpigmented portion of skin and thereby improving the appearance of skin color.

Appellant asserts the Hineno teaching is limited to using only red interference pigments for the method of covering skin wrinkles. Appellant's argument is unpersuasive, as it is well settled in patent law that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). In the present case, compositions comprising red interference pigment are a mere preferred embodiment suitable for particular cosmetic compositions, since cosmetics are not in uniform color. For example, Hineno teaches in col. 7, lines 33-42,

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that the prior art external compositions are designed to have "various colors" without particular limitations. See also Kimura's compositions comprising blue interference pigments. In response to the appellant's arguments, examiner respectfully points out to col. 8, lines 1 – 9 of the reference. The reference teaches interference pigment in decorative beauty products works due to "the light interference caused in the composite powder layer having the uniform particle diameter formed on the skin so that the composite powder layer exhibits a color on the skin and various interference color are observed". Thus, it is viewed that the Hineno examples impart the cosmetic effect due to the light interference property of the pigment, rather than the particular reflectance color of the pigment. A skilled artisan reading the Hineno reference would not be led to believe that only a particular colored interference pigments would be useful in cosmetics and or effective in lines and wrinkle reduction in skin makeup compositions. Particularly in makeup cosmetic art, it is not surprising to use a variety of colors to accommodate different skin colors and tones of diverse consumer population. For example, Kimura suggests the endeavor made in cosmetic art to make formulations with different colors to meet the need of diverse skin color of users. It is obvious that a reasonable ordinary skill in the art would have looked for interference pigments of different color and reflectance to treat the wrinkles and lines of the subjects of different skin tone, and the claimed invention is viewed an obvious variation of the combined teachings of the prior arts.

Appellant further argues that the prior art examples comprising red interference pigments are not a mere preferred embodiment and fail suggest a composition

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comprising “a composite powder having a blue reflectance” would have any wrinkle covering effect. In response, examiner asserts that such argument is not commensurate with the scope of the claims. While the composition of the present claims merely comprises at least one interference pigment having blue or violet reflectance, the primary color of the “composite powder” or the resulting composition does not necessarily have to be of these reflectance. The present independent claims do not in fact exclude using red interference pigment in combination with blue or violet interference pigments; nor do these claims limit the amount of the blue/violet interference pigments relative to other components present in the composition. For example, the “at least one metal oxide pigment” reads on interference pigments of red color of Composite Powder (I) used in the Hineno examples, as these pigments are essentially coated metal oxides (i.e., titanium oxide coated mica). See Production Examples. Thus blue/violet interference pigment is not necessarily the only essential interference pigment used in the present method. Furthermore, Claim 11 limits that the interference pigment of the base claim, claim 1, has only a blue reflectance, without any limitation on the weight ratio of the pigment relative to other pigments present in the composition. Thus, the present method is open to using a composition which comprises at least one blue or violet interference pigment in combination of the active ingredient that is used in the prior art examples. Appellant’s assertion that the present claims are patentably distinct and nonobvious over the Hineno examples is therefore unpersuasive.

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Appellant also argues that limiting the compositions of the invention to no greater than 15 % and preferably to no greater than 10 % by weight of inorganic powders results in a more translucent, natural appearance to the skin. Appellant compares the claimed composition to Example 13 of Kimura, which, according to appellant, contains 58.8 % of inorganic, non-interference pigment powders. The reason this particular exemplary formulation of Kimura contains such high amount of inorganic powders is that the composition is a powdery foundation. Furthermore, appellant's argument is not commensurate with the scope of the claim because claims 6 and 35 requires "**at least one** inorganic, non-matte, non-spherical powder" in an amount ranging from about 2-10 % by weight of the composition, and does not preclude the presence of other type of inorganic, non-matte-non-spherical powders present in the composition. As pointed out in the rejection, Hineno Examples 2 and 6 employ 7 % and 5.36 % of sericite, respectively, in combination with interference pigments. The foundation of Example 7 particularly employs other dyes and colorants such as red, yellow, and black iron oxide to match skin color. In view of the prior art disclosure, appellant's limitation, about 2-10 % by weight of "at least one inorganic, non-matte- non-spherical powder", does not render the present composition novel or nonobvious. As discussed in the rejection, the disclosed examples of Hineno already employ inorganic powders within these amounts, and it is no surprising or unexpected for one of ordinary skill in the art to make cosmetic compositions as appellant has done in this case.

ii) Claims 1-7, 9-11 and 35 have been properly rejected over Hineno in view of Kimura.

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Examiner asserts that the present method only takes an obvious modification of the Hineno and Kimura inventions. According to these references, the utility of interference pigments to reduce the appearance of skin defects, which include wrinkles and uneven skin tone, already has been known in cosmetic industry. Both references teach that interference pigments are available in various colors or reflectance; it was well within the skill of the art to compound decorative cosmetics in different colors to meet the consumer's demands and needs, as shown in Kimura. It would have been obvious that these teachings would have motivated a skilled artisan to use a cosmetic composition comprising an interference pigment of color and reflectance that already has been in use in the industry, with a reasonable expectation of efficacy of covering skin defects such as aging skin.

ii) Claim 8 has been properly rejected over and Kimura and further in view of Hurst.

Appellant argues that incorporating bismuth oxychloride in view of the combined references would not have been obvious. Appellant refers to a portion in Kimura, which suggests applying another layer of cosmetic composition to the interference pigment coating layer in order to suppress the gloss of the hyperchromic portion of the coated skin and to yield a finishing feel which is comparable to the normal portion.

However, appellant's argument does not take into account of the specific teaching in Hurst which forms the basis of the present rejection; the reference indicates that the very motivation for a skilled artisan to employ bismuth oxychloride is to produce enhanced "natural", not glossy, complexion of the skin. Also, appellant's argument is

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not commensurate with the scope of the claim because the presently claimed method does not prevent the users to also apply extra layers of cosmetics over the skin coated with the composition of the present claims to produce maximum natural appearance.

Kimura merely shows that once the composition to hide skin defect is applied, subsequently making up the skin with a finishing composition is well within the skill in cosmetic art.

Contrary to appellant's arguments, Hurst teaches the specific benefit of using bismuth oxychloride in a cosmetic composition. Such disclosure would have obviously motivated a skilled artisan who was seeking a cosmetic method of producing enhanced natural appearance of skin, to use this particular pigment to meet this goal. Thus, examiner asserts that a prima facie case of obviousness has been properly made in this case.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/GINA CHIEUN. YU/
Primary Examiner, Art Unit 1611

Conferees:

Art Unit: 1611

/David J. Blanchard/

Acting Supervisory Patent Examiner, Art Unit 1611

/Ardin Marschel/

Supervisory Patent Examiner, Art Unit 1614